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REMARKS

The Office Action mailed April 16, 2007 has been received and reviewed. Claims 1-60 are in the case. Claims 1-60 stand rejected under 35 U.S.C. § 103(a).

For the reasons set forth below, claims 1-60 are believed to be in condition for immediate allowance. Favorable reconsideration of the application in view of the following remarks, is therefore respectfully requested.

Rejection of Claims 1, 2, 5-29, 31-52, and 54-60 Under 35 U.S.C. §103(a)

Claims 1, 2, 5-29, 31-52, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of De Paoli. However, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* MPEP 2143. Also, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* Applicant asserts that the combination of Johnson and De Paoli does not meet either requirement.

With respect to the first requirement, the Office Action admits that Johnson does not disclose applying a substantially random distribution of medallions to a substrate. However, the Office Action asserts that one of ordinary skill in the art would have been motivated to modify the method of Johnson to include De Paoli's irregular distribution of spatters (which the Office Action interprets as randomly distributed). Applicant respectfully disagrees.

Applicant respectfully asserts that Johnson requires a mold. *See* Johnson at Figure 2. Johnson's mold is antithetical to any random application of medallions. Molds are designed and fabricated before any parts can be produced using them. Molds must be designed well in

advance. Once designed and substantially made, they are fixed, unchangeable. Molds, therefore, inherently provide regularity and predictability in producing the same part, time-after-time. Thus, since the Office Action equates De Paoli's irregular distributions with random distributions, Johnson's molding technique teaches against De Paoli's irregular distribution of spatters. Applicant asserts that this teaching against by Johnson destroys the requisite motivation to modify Johnson to include the irregular distributions taught by De Paoli.

With respect to the second requirement, Applicant's claims require that the medallions be applied onto the top surface of a substrate. Applicant finds no teaching or suggestion in Johnson nor De Paoli of applying medallions in that recited manner. While the Office Action asserts that Johnson's "layer of concrete 5" and "stone-like bodies B" may respectively be considered to be Applicant's recited substrate and medallions, Applicant does not find in Johnson any teaching or suggestion of applying bodies B onto a surface of concrete layer 5. In contrast, Applicant respectfully asserts that Johnson teaches the opposite.

That is, first "the concrete for the stone-like bodies B is placed in cavities C." *See* Johnson at col. 4, lns. 30-32. Next, "[t]he layer of concrete 5 is then applied." *See* Johnson at col. 4, lns. 39-41. At the time the "bodies B" are created, the layer 5 does not even exist. Thus, as seen in Figure 2, Johnson teaches applying concrete layer 5 onto stone-like bodies B, not vice versa as would be required to obviate Applicant's claim.

Similarly, Applicant does not find in De Paoli any teaching or suggestion of applying medallions onto the top surface of a substrate. While the Office Action asserts that De Paoli's "terrazzo base" and "spatter inserts" may respectively be considered to be Applicant's recited substrate and medallions, Applicant does not find in De Paoli any teaching or suggestion of applying spatter inserts onto a top surface of a terrazzo base. In contrast, Applicant respectfully

asserts that the "spatter inserts" of De Paoli are, as implied by the name "insert," embedded into the terrazzo base. *See* De Paoli at col. 1, ln.70 through col. 2, ln. 2 (stating "terrazzo spatters, ..., of suitable configuration, size and design are then inserted in selected areas of the semi-plastic slab" emphasis added) and at col. 4 lns. 17-18 (stating that the spatters are "located in the base layer to provide an ornamental design," emphasis added).

In view of the foregoing, Applicant respectfully asserts that Johnson's molding is antithetical to DePaoli's irregular distribution of spatters, thereby precluding the required motivation or suggestion to combine. Moreover, Applicant respectfully asserts that the references taken together still lack required structures. Applicant asserts that neither Johnson nor De Paoli teach or suggest applying medallions onto the top surface of a substrate. Accordingly, Applicant asserts that the rejection based on a combination of Johnson and De Paoli is improper on two, independent bases and should be withdrawn. Reconsideration is respectfully requested.

Rejection of Claims 3, 4, and 30 Under 35 U.S.C. §103(a)

Claims 3, 4, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of De Paoli and further in view of Arpin. However, as set forth hereinabove, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* MPEP 2143. Also, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* Applicant respectfully asserts that the combination of Johnson, De Paoli, and Arpin does not meet either requirement.

As presented hereinabove, Applicant asserts that there can be no proper suggestion or motivation to incorporate the irregularity of De Paoli into the regular molded shape of Johnson. Applicant further asserts that Applicant's claims require elements not taught nor suggested by Johnson or De Paoli. Adding the teachings of Arpin to those of Johnson and De Paoli does not remedy the situation. For example, as with those references, Applicant does not find in Arpin any teaching or suggestion of applying a medallion onto the top surface of a substrate. Accordingly, reconsideration is respectfully requested.

Rejection of Claim 53 Under 35 U.S.C. §103(a)

Claim 53 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of De Paoli and further in view of Maletic. However, as set forth hereinabove, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP 2143. Also, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* Applicant asserts that the combination of Johnson, De Paoli, and Maletic does not meet either requirement.

As presented hereinabove, Applicant respectfully asserts that Johnson's molding is antithetical to DePaoli's irregular distribution of spatters, thereby precluding the required motivation or suggestion to combine. Applicant further asserts that Applicant's claims require elements not taught or suggested by Johnson or De Paoli. Adding the teachings of Maletic to those of Johnson and De Paoli does not remedy the situation. For example, as with those

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references, Applicant does not find in Maletic any teaching or suggestion of applying a medallion onto the top surface of a substrate. Accordingly, reconsideration is respectfully requested.

Rejection of Claims 12, 15-20, and 54-60 Under 35 U.S.C. §103(a)

Claims 12, 15-20, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of De Paoli and further in view of Gundlach and Chaffee. However, as set forth hereinabove, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* MPEP 2143. Also, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* Applicant asserts that the combination of Johnson, De Paoli, Gundlach, and Chaffee does not meet either requirement.

As presented hereinabove, Applicant respectfully asserts that Johnson's molding is antithetical to DePaoli's irregular distribution of spatters, thereby precluding the required motivation or suggestion to combine. Applicant further asserts that Applicant's claims require elements not taught or suggested by Johnson or De Paoli. Adding the teachings of Gundlach and Chaffee to those of Johnson and De Paoli does not remedy the situation. For example, as with those references, Applicant does not find in Gundlach or Chaffee any teaching or suggestion of applying a medallion onto the top surface of a substrate, as required by Applicant's claims. Accordingly, reconsideration is respectfully requested.

In the event that the examiner finds any remaining impediment to the prompt allowance of any of these claims, which could be clarified in a telephone conference, the examiner is respectfully urged to initiate the same with the undersigned.

DATED this 18th day of June, 2007.

Respectfully submitted,



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